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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,383	07/21/2003	L. Thomas Hayes	ITW 13194.60	6819
23721	7590	08/04/2005	EXAMINER	
CORRIGAN LAW OFFICE 5 BRIARCLIFF CT APPLETON, WI 54915			SHAW, CLIFFORD C	
			ART UNIT	PAPER NUMBER
			1725	

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/624,383

Applicant(s)

HAYES, L. THOMAS

Examiner

Clifford C. Shaw

Art Unit

1725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/30/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0915</u> . | 6) <input type="checkbox"/> Other: ____ |

Detailed Action

1.) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.) Claims 20-21 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 20 and 22 depend from "... the system of claim 15", but claim 15 is a method, making it unclear what scope applicant intends in claims 20 and 22. The other claims are inadequate under 35USC112 in that they depend from claims 20 and 22.

3.) The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4.) Claims 1-45 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,639,182. Although the conflicting claims are not identical, they are not patentably distinct from each other because

Art Unit: 1725

the application claims are broader in scope than the corresponding patent claims and are therefore obvious over the subject matter of the patent claims.

5.) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6.) Claims 1, 4-7, 16-19, 23-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Beiermann et al. (6,479,792). In column 5, line 66 through column 6, line 10 and at column 6, line 60-column 7, line 5, the patent to Beiermann et al. (6,479,792) discusses the use of a pda to connect to a welding system and to download welding programs to the system. In column 3, line 60 through column 4, line 10 the patent to Beiermann et al. (6,479,792) discusses the use of either wired or wireless connection of the gateway device (which can be a pda) to the welding system.

Art Unit: 1725

7.) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8.) Claims 2, 8-10, 12, 14, 15, 27, 29, 32, 35-37, and 40-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beiermann et al. (6,479,792). The patent to Beiermann et al. (6,479,792) discloses the subject matter claimed, except: the limitations directed to uploading a program from a "welding-type system" as in claims 2 and 40; explicit mention of plural programs stored in the pda as in several of the claims; the controller memory limitations in claims 27 and 29; and explicit mention of a program as in claims 32 and 35. These differences do not patentably distinguish over the prior art. In column 6, lines 40-65, the patent to Beiermann et al. (6,479,792) discusses uploading welding software from external sources. It is considered obvious that these external computer systems are "welding-type systems" at least because they contain welding software. It is considered obvious that plural programs are available on the user interface device discussed in Beiermann et al. (6,479,792) in view of his references to plural configurations for example at column 3, lines 39-45 and at column 6, lines 60-66. In regard to claims 27 and 29, it is considered obvious that memory 24 in Beiermann et al. (6,479,792) stores welding programs because this is the only area for such programs to be stored in the welding controller. In regard to claims 32 and 35, applicant is advised that programs *per se* are not patentable under 35USC101. However, claim 32 includes a positive

Art Unit: 1725

statement that the storage routine "... stores at least one weld schedule in a memory on a pda" and claim 35 includes a positive statement that a storage routine "stores a plurality of weld schedules in a memory of the pda". In both of these instances, the memory of the pda is considered to be a structural element of the claimed subject matter. It is considered obvious that the welding configurations and programs controlled by the pda in the system of Beiermann et al. (6,479,792) be stored at some point in the pda's memory since the configurations and programs are disclosed as being set by the pda and therefore must obviously be stored in the memory of the pda.

9.) Claims 3, 11, 28, 33, 34, 38, 39, and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beiermann et al. (6,479,792) as applied to the claims above, and further in view of Blankenship et al. (6,624,388). The only aspect of the claims to which the rejections above do not apply is the provision for the use of email. This difference does not patentably distinguish over the claimed invention. At the time applicant's invention was made, it would have been obvious to have incorporated email into the welding control system taught by Beiermann et al. (6,479,792), the motivation being the teachings of Blankenship et al. (6,624,388) that it is advantageous to use email in a networked welding control system (see the discussion of the SMTP and the POP3 protocols used for communicating with the welding system controller in column 11, lines 45-65 in Blankenship et al. (6,624,388)).

10.) Claims 13, 30, and 31 are objected to for depending from rejected claims and for being obvious over the claims of patent no. 6,639,182, but would be given favorable

Art Unit: 1725

consideration if the obviousness-type double patenting rejection above is overcome and if recast in independent form to include all of the limitations of the parent claims. None of the prior art of record teaches or suggests the limitations associated with sending a portion of a file containing plural programs as set forth in the claims, combined with the other claim features.

11.) The patent to Takaoka et al. (6,167,328) is cited to show a prior art welding arrangement that includes a personal digital assistant type device (see figure 5 of the patent).

Any inquiry concerning this communication should be directed to Clifford C Shaw at telephone number 571-272-1182. The examiner can normally be reached on Monday through Friday of the first week of the pay period and on Tuesday through Friday of the second week of the pay period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Thomas G. Dunn, can be reached at 571-272-1171. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 1725

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Clifford C Shaw
Primary Examiner
Art Unit 1725

August 2, 2005